

Express Mail No.: _____

#8
LB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Harrington *et al.*

Application No.: Re. 09/586,744

Group Art Unit: 1652

Filed: June 2, 2000

Examiner: T. Saidha

For: MAMMALIAN-SPECIFIC FLAP
ENDONUCLEASE

Attorney Docket No.: 9584-017-999

RECEIVED
FEB 15 2001
TECH CENTER 1600/2900

Response to Reissue Application Protest

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants are in receipt of a communication entitled REISSUE APPLICATION PROTEST UNDER 37 C.F.R § 1.291 (the "Protest") protesting the instant reissue application. Although not required to respond, *see* 37 C.F.R. § 1.291(c), Applicants have noticed that the Protest is so fraught with legal errors they have opted to submit the following remarks to clarify the record.

REMARKS

I. THE INSTANT REISSUE APPLICATION SATISFIES ALL OF THE STATUTORY REQUIREMENTS OF 35 U.S.C. § 251

The reissue statute provides in pertinent part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and

the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced in to the application for reissue.

* * *

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

35 U.S.C. § 251. Thus, a broadening reissue application must satisfy five statutory requirements: (1) the patentees must believe the original patent to be wholly or partly inoperative or invalid due to one of four statutorily-defined correctable defects, such as the patentee claiming less than he had a right to claim; (2) the correctable defect must have arisen through an error without any deceptive intention; (3) the reissue application must be for the invention disclosed in the original application; (4) no new matter shall be introduced into the reissue application; and (5) the reissue application must be filed within two years of the grant of the original patent. *See, e.g., In re Amos* 21 USPQ2d 1271, 1273-74 (Fed. Cir. 1991). For convenience, these requirements are typically referred to as the “correctable defect,” “error,” “original patent,” “new matter” and “time” requirements, respectively. As will be discussed more thoroughly below, the instant broadening reissue application satisfies all five statutory requirements.

A. The Instant Application Is Based upon a Statutorily-Defined Correctable Defect That Arose Through and Error Without Deceptive Intention

The present broadening reissue application was filed to remedy a statutorily-defined correctable defect: the inventors claimed less than they had a right to claim in the original patent. As stated in their Reissue Declaration, this correctable defect arose due to an error without any deceptive intention. Specifically, the present reissue application was filed to obtain issuance of claims drawn to inventions that were disclosed in the original patent application, but due to error without any deceptive intention, were never claimed during the prosecution of the original patent.

These disclosed but unclaimed inventions are embodied in Claims 7-73 of the instant reissue application, and are distinct from those originally claimed. For example, whereas the original claims were drawn to FEN-1 polypeptides (Claims 1-5), polynucleotides encoding a FEN-1 polypeptides (Claims 6-9) and host cells comprising such encoding polynucleotides or polypeptides (Claims 10 and 11, respectively), Claims 7-73 of the instant reissue application are drawn to methods involving the cleavage of certain structures (Claims 7-50), hybridization complexes (Claims 51-58) and kits comprising a FEN-1 polypeptide and certain polynucleotides (Claims 59-73).

Not only is the present situation common, it is exactly the type of situation the reissue statute was designed to remedy:

[A] primary purpose of the reissue statute is to enable the addition of claims to subject matter not claimed in the original patent.

C.R. Bard, Inc. v. M3 Systems, Inc., 48 USPQ2d 1225, 1234 (Fed. Cir. 1998), *rehearing and suggestion for rehearing en Banc denied*, 49 USPQ2d 1319 (Fed. Cir. 1998), *cert. denied*, 526 U.S. 1130 (1999). *See also, Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ2d 1001, 1009 (Fed. Cir. 1991) (“[T]he purpose of the reissue statute is to avoid forfeiture of substantive rights due to error made without intent to deceive.”); *In re Wilder*, 222 USPQ 369, 371-72 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 1209 (1985) (“[P]urpose of reissue is to correct errors such as misunderstanding scope of the invention and claiming less than that to which the inventor was entitled.”).

The inventors state in their Reissue Declaration that the error which resulted in their correctable defect of claiming less than they had a right to claim, and hence the filing of the instant reissue application, was their failure at the time of the original patent grant to recognize that the application as originally filed disclosed patentable inventions beyond those originally and ultimately claimed. Such errors of misunderstood scope are clearly remediable by reissue:

An inventor's failure to appreciate the scope of an invention at the time of the original patent grant . . . is a remediable error.

C.R. Bard, 48 USPQ2d at 1234.

Thus, as evidenced by the inventors' Reissue Declaration, the instant broadening reissue application satisfies the "correctable defect" and "error" prongs of the reissue statute: through error of misunderstood scope, and without any deceptive intention, the inventors believe their original patent to be wholly or partly inoperative or invalid by reason of claiming more or less than they had a right to claim.

Yet, the Protester urges that no "proper" correctable error has been identified or alleged. The Protester's arguments are without merit.

First, the Protester suggests that failing to recognize or appreciate the patentability of inventions is not an error of scope. The prevailing case law says otherwise. In numerous cases where an error of misunderstood scope was alleged, it stemmed from a failure to recognize that inventions claimed in the reissue application were patentable. *See, e.g., In re Swartzel*, 36 USPQ2d 1510, 1511 (Fed. Cir. 1995) (unpublished) (inventor's declaration establishing that he originally believed product claims were unpatentable over prior art constituted error remediable by reissue). The Protester also urges the odd view that while an *attorney's* failure to appreciate the scope of an invention constitutes an error that can be remedied by reissue, an *inventor's* failure to do the same does not. However, as demonstrated by the above-quoted language from *C.R. Bard*, inventor errors of misunderstood scope are remediable by reissue. *See also, In re Swartzel*, 36 USPQ2d 1510 at 1511, *supra*.

Lastly, the Protester suggests that no correctable error exists because the inventors did not file a divisional application directed to their canceled FEN-1 polypeptide claims.^{1/} Apparently, the Protester construes *In re Weiler*^{2/} as promulgating the mechanical rule that failing to file a divisional application directed to previously claimed but non-elected inventions bars a reissue applicant from claiming *other* inventions that were disclosed, but *never* claimed, in the original patent.

The Protester reads *In re Weiler* too broadly. First, the Federal Circuits' decision to deny Weiler's *appealed* claims was not grounded upon Weiler's failure to file a divisional application. Although Weiler's reissue application as filed claimed two categories of inventions: (1) inventions that were claimed in the original application and canceled in response to a restriction requirement; and (2) inventions that were disclosed, but never claimed, in the original application, *only the second category of claims were appealed to the Federal Circuit*.^{3/} The Federal Circuit clearly stated that Weiler's failure to file a divisional application had *no bearing* on its decision regarding the disposition of the *appealed* claims:

^{1/} The original patent (U.S. Patent No. 5,874,283; the "'283 patent") issued on application Serial No. 08/455,968, filed May 30, 1995 (the "'968 application"). As originally filed, the '968 application contained eleven claims: five drawn to FEN-1 polypeptides (Claims 1-5); four drawn to polynucleotides encoding a FEN-1 polypeptide (Claims 6-9); one drawn to host cells comprising a recombinant polynucleotide encoding a FEN-1 polypeptide (Claim 10); and one drawn to host cells comprising a mammalian FEN-1 polypeptide (Claim 11).

In a first Office Action mailed July 21, 1997, the Patent Office issued a Restriction Requirement dividing the pending claims into two groups: Group I (Claims 1-5) drawn to FEN-1 polypeptide; and Group II (Claims 6-11) drawn to polynucleotides encoding FEN-1 polypeptide and host cells. In response, the Applicants elected to prosecute the claims of Group II (Claims 6-11), without traverse. The non-elected claims were canceled in a telephonic interview dated July 13, 1998 and the elected claims were prosecuted to issuance. A divisional application directed to the non-elected FEN-1 polypeptide claims was not filed.

^{2/} *In re Weiler*, 229 USPQ 673 (Fed. Cir. 1986).

^{3/} The Board rejected the first category of claims under *In re Orita*, finding that the failure to file a divisional application drawn to *originally claimed, but non-elected inventions*, does not constitute a correctable error. Weiler did not appeal the Board's rejection. See *In re Weiler*, 229 USPQ at 674 and 675.

[T]he discussions in the briefs concerning the failure to assert the non-elected claims in a divisional application *are irrelevant*. Those claims are not on appeal. . . .

In re Weiler, 229 USPQ at 667 (emphasis supplied). Instead, Weiler was barred from obtaining the appealed claims by reissue because nothing in the record indicated that his failure to claim the subject matter of the appealed claims was due to *error*:

Nor has Weiler made *any showing* on which error could be found as the cause of his failure to claim the subject matter of [the appealed claims].

In re Weiler, 229 USPQ at 677 (emphasis supplied).

Thus, the holding of *In re Weiler* is quite narrow and limited to the specific facts of record. In fact, the holding of *In re Weiler* is inapposite to the instant reissue application. Quite unlike the situation in *In re Weiler*, the instant reissue application clearly states an error that the Federal Circuit has repeatedly recognized as being correctable by reissue.

Moreover, whatever relevance *In re Weiler*'s "intent to claim" analysis might appear to have regarding the appealed claims, the logical underpinnings of *In re Weiler* have been squarely addressed and rejected by the Federal Circuit in *In re Amos*, 21 USPQ2d 1271 (Fed. Cir. 1991).

Similar to the situation in *In re Weiler*, in *In re Amos* Amos attempted to claim in a reissue application an invention that was disclosed, but never claimed, in the original application. Although the *Amos* Board found that Amos had demonstrated an error, it nonetheless denied Amos' reissue claims under the "intent to claim" rubric of *In re Weiler*:

the disclosure of the original patent failed to set forth an "intent to claim" the subject matter for which protection was sought.

In re Amos, 21 USPQ2d at 1273.

The stage set, the Federal Circuit squarely addressed “the proper role under 35 U.S.C. § 251, if any, for the concept of an ‘intent to claim’ in a rejection of claims submitted during reissue.” *In re Amos*, 21 USPQ2d at 1273. First, the Court stated that demonstrating an “intent to claim” is *not* a statutory requirement and it *does not* have a life of its own separate and distinct from the statute.^{4/} Rather, determining whether the claims drawn to the previously unclaimed inventions satisfy the reissue statute requires only a two prong analysis: (1) determining that the correctable defect arose due to an error without deceptive intention; and (2) determining that the reissued patent is for the invention disclosed in the original patent. *In re Amos*, 21 USPQ2d at 1273-74. There is no requirement of demonstrating a subjective “intent to claim” the inventions being claimed in the reissue application.

Moreover, to the extent that an “intent to claim” analysis is applied at all, the Federal Circuit made crystal clear that it is merely a shorthand way of analyzing the second, “original patent” prong of the reissue statute:

Thus, we must read the Board’s invocation of the “infelicitious” phrase, “intent to claim,” as a decision that the new claims were not “for the invention disclosed in the original patent

In re Amos, 21 USPQ2d at 1274 (citations to *Weiler* omitted). As noted by the Court, “‘intent to claim’ has little to do with ‘intent’ *per se*, but rather is analogous to the requirement of § 112, first paragraph that the specification contain a ‘written description of the invention It is, as appellant urges, synonymous with ‘right to claim.’” *In re Amos*, 21 USPQ2d at 1274, quoting *In re Mead*, 198 USPQ 412, 417 (CCPA 1978).

Accordingly, applicants for reissue are entitled, upon alleging a statutorily-defined defect and establishing the requisite statutory error, to claim inventions disclosed, but never claimed, in the original patent. This holding is consistent with later cases such as *C.R. Bard* which, as

^{4/} *In re Amos*, 21 USPQ2d at 1274 (“As is apparent from the foregoing statutory analysis, ‘[t]he phrase intent to claim does not appear in the statute.’”), quoting *In re Weiler*, 229 USPQ at 676; See also, *Scripps Clinic*, 17 USPQ2d at 1009 (“‘Intent to claim’ is not the criterion for reissue.”).

discussed above, recognize that not only is claiming such disclosed but previously unclaimed inventions proper, it is one of the primary defects the reissue statute was designed to redress. See page 3, *supra*.

The instant reissue application is based upon the statutorily-defined defect of the inventors claiming less than they had a right to claim. Quite unlike the situation in *Weiler*, the instant Reissue Declaration clearly and unequivocally states that the correctable defect was due to an error without any deceptive intention. Namely, the failure to recognize at the time of the original patent grant that inventions disclosed but never claimed in the original patent were patentable. The Federal Circuit has repeatedly held that such errors of misunderstood scope are correctable by reissue. Significantly, the *Amos* Court has held that the far more ambiguous error of mere “oversight” satisfied the error prong of the statute. Accordingly, it is clear from the present record that the “correctable defect” and “error” requirements of 35 U.S.C. § 251 have been met.

B. The Instant Reissue Application Is for the Invention Disclosed in the Original Patent and Does Not Introduce New Matter

The reissue statute also requires that the reissue patent be “for the invention disclosed in the original patent,” and that no new matter be introduced into the application for reissue. 35 U.S.C. § 251. The instant reissue application satisfies both of these statutory requirements.

Much ado has been made about the meaning of the “original patent” requirement of the reissue statute. The Federal Circuit has squarely addressed and settled this issue in *In re Amos*:

[T]he essential inquiry under the “original patent” clause of § 251 . . . is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees.

In re Amos, 21 USPQ2d at 1275; see also, *Hester Industries Inc. v. Stein*, 46 USPQ2d 1641, 1651 (Fed. Cir. 1998). The *Amos* court specifically noted that this inquiry is analogous to the

written description requirement of 35 U.S.C. § 112, first paragraph. Thus, the essential inquiry that must be undertaken to determine whether the claims of a reissue application are for the invention disclosed in the original patent is:

to examine the entirety of the original disclosure and decide whether, through the "objective" eyes of the hypothetical person having ordinary skill in the art, an inventor could fairly have claimed the newly submitted subject matter in the original application.

Id. Any inventions that the inventors could have claimed in their original application are therefore ripe for claiming in a reissue application.

An examination of the original disclosure in its entirety reveals that the inventions embodied in Claims 7-73 could have been claimed in the original application. Claims 7-50 are drawn to methods involving cleavage of certain structures, Claims 51-58 are drawn to hybridization complexes^{5/} and Claims 59-73 are drawn to kits comprising a FEN-1 polypeptide and certain polynucleotides. These various methods, hybridization complexes and kits are described in the '283 patent at Col. 11, lines 3-48 and again at Col. 40, line 19 through Col. 43, line 59. Moreover, it is clearly stated that these various methods, hybridization complexes and kits may be practiced with DNA flap substrates described in certain of the inventors' own publications:

DNA flap substrates, cleavage and binding reactions and the like are practiced with reference to the Experimental Examples . . . and Harrington and Lieber (1995) *J. Biol. Chem.* 270:4503.

^{5/} The hybridization complexes recited are substrates for flap endonucleases such as FEN-1 polypeptides.

'283 Patent at Col. 39, line 65 through Col. 40, line 3. The cited Harrington and Lieber reference teaches the "double flap" substrates or cleavage structures that are recited in Claims 7-73.^{6/}

Accordingly, while the various methods, compositions and kits of the invention are illustrated by way of the 5'-flap structure presented in FIG. 6 of the '283 patent, one of skill in the art reading the disclosure in its entirety would immediately recognize that the various methods, compositions and kits of the invention also include or may be practiced with the DNA flap substrates, and specifically the "double flap" substrates, taught in the references incorporated into the specification at Col. 39, line 65 through Col. 40, line 3. The subject matter of Claims 7-73 could therefore have been claimed in the original application. Moreover, as demonstrated in note 7, *infra*, and "no new matter" has been introduced into the reissue application. Consequently, the instant reissue application satisfies the "original patent" and "new matter" requirements of 35 U.S.C. § 251.

C. The Reissue Application Was Filed Within the Two Year Time Limit Prescribed by the Reissue Statute

Finally, the reissue statute requires that:

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

35 U.S.C. § 251. The '283 patent issued on February 23, 1999. The instant reissue application was filed on June 2, 2000, well within the two-year time limit specified in the statute.

^{6/} It has long been recognized that subject matter specifically referenced in publicly available materials such as journal articles is incorporated by reference into the application. *See, e.g., In re Fouche*, 169 USPQ 429 (CCPA 1971). Such incorporated subject matter constitutes a part of the original disclosure, and explicitly amending it into the body of the application does not introduce "new matter." *See, e.g., MPEP* § 608.01(p)(2).

II. THE CLAIMS OF THE REISSUE APPLICATION DO NOT RUN AFOUL OF THE RECAPTURE DOCTRINE

Once the statutory requirements have been satisfied and it has been determined that the claims of the reissue application are broader than the originally granted claims, care must be taken to insure that the reissue claims do not run afoul of the recapture doctrine by attempting to recapture subject matter surrendered during the prosecution of the original patent:

Under the recapture rule, claims that are “broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution” are impermissible.

Hester Industries, 46 USPQ2d at 1648, *quoting In re Clement*, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997). The recapture rule, therefore, prevents a patentee from regaining through reissue subject matter that he surrendered in an effort to obtain allowance of the original claims. *Id.*

As discussed above, and as repeatedly pointed out by the Protester, Applicants have not amended their original Claims 1-6 and their new Claims 7-73 are drawn to inventions distinct from those recited in original Claims 1-6. Any subject matter surrendered to obtain allowance of original Claims 1-6 is irrelevant to Claims 7-73. These claims and original Claims 1-6 do not share the same points of novelty and non-obviousness. Accordingly, Claims 7-73 do not run afoul of the recapture doctrine.

III. CONCLUSION

As evidenced by the above discussion, the instant reissue application satisfies all of the requirements of the reissue statute. Specifically: (1) the instant reissue application is based upon the statutorily-defined correctable defect of the inventors claiming less than they had a right to claim; (2) the defect arose through an error of a type commonly deemed correctable by reissue that was made without deceptive intention; (3) the claims of the reissue application are for the invention disclosed in the original patent; (4) no new matter is introduced into the reissue

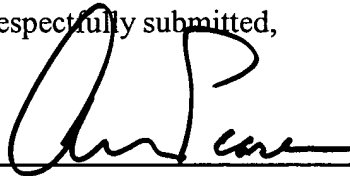
application; and (5) the reissue application was filed within two years from the grant of the original patent. Moreover, none of the claims of the reissue application attempt to recapture subject matter surrendered to secure allowance of the original claims.

The Federal Circuit has explicitly stated that once the statutory requirements for reissue have been met, reissue of the patent is not discretionary— it is mandatory. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ2d at 1009 (Fed. Cir. 1991) (“When the statutory requirements [for reissue] are met, reissuance of the patent is not discretionary with the Commissioner; it is mandatory (‘shall’).”). Accordingly, Applicants respectfully submit that the instant reissue application is in condition for substantive examination.

Respectfully submitted,

Date

2/14/01



Ann M. Caviani Pease

42,067

(Reg. No.)

Enclosures

for:

Samuel B. Abrams, Reg. No. 30,605
PENNIE & EDMONDS LLP
1155 Avenue of the Americas
New York, New York 10036-2711
(212) 790-9090

In re Weiler, et al., 229 USPQ 673 (CA FC 1986)

In re Weiler, et al.

**(CA FC)
229 USPQ 673**

Decided May 8, 1986

No. 85-2085

U.S. Court of Appeals Federal Circuit

Headnotes

PATENTS

1. Reissue -- Inadvertence, accident and mistake (§ 58.3)

PTO Appeal Board's finding that subject matter of claims in reissue application was not claimed in original application, and its finding that nothing in original patent evidences applicant's "intent to claim" that subject matter, supports its finding that such failure was not "error" intended to be corrected by reissue under 35 USC §251.

Particular Patents -- Chemical

Reissue application No. 408,497, Method for Quantitative Analysis for Limonin, rejection of claims 13 and 19 sustained.

Case History and Disposition:

Appeal from Patent and Trademark Office Board of Patent Appeals and Interferences.

Reissue application, Serial No. 408,497, by Elmar W. Weiler and Richard L. Mansell. From decision

sustaining rejection of claims 13 and 19, applicants appeal. Affirmed.

Attorneys:

William D. Stokes, Alexandria, Va., for appellants.

Richard E. Schafer, Associate Solicitor, Arlington, Va. (Joseph F. Nakamura, Solicitor, and Fred E. McKelvey, Deputy Solicitor, on the brief) for appellee.

Judge:

Before Markey, Chief Judge, Davis and Bissell, Circuit Judges.

Opinion Text

Opinion By:

Markey, Chief Judge.

Weiler and Mansell (Weiler) appeal from a decision of the United States Patent and Trademark Office Board of Appeals (board), App. No. 600-54 (Dec. 31, 1984), affirming the examiner's rejection of claims 13 and 19 in a reissue application filed under 35 U.S.C. §251 (1982). We affirm.

Page 674

Background

Weiler filed an application on May 8, 1980, containing 11 claims. During prosecution, the examiner held that the application contained "three independent and distinct inventions" and required restriction between Claims 1-7 (assay method), Claims 8 and 11 (an "organic compound" in class 260/343.42), and Claims 9 and 10 (a "protein compound" in class 260/121). Weiler elected to prosecute Claims 1-7. Those claims were allowed without amendment, and the application issued on December 15, 1981 as U.S. Patent No. 4,305,923 ('923 patent) for a "Method for Quantitative Analysis for Limonin".

1. U.S. Patent No. 4,305,923

The seven claims of the patent are independent claim 1 and dependent claims 2-7. Claim 1 reads:

1. A method for quantitative analysis of limonin which comprises reacting a known amount of limonin-specific antibodies, with a mixture of a known volume of sample containing an unknown amount of limonin and a known amount of a limonin-derivative labeled with an enzyme or with a radioactive isotope, determining the amount of labeled limonin-derivative which has reacted with said antibodies and calculating therefrom the unknown amount of limonin in said sample.

2. The Reissue Application

Weiler did not contest the examiner's requirement for restriction and did not file a divisional application, to assert the non-elected claims or any other claims.

On August 18, 1982, Weiler filed application Serial No. 408,497 to reissue the '923 patent. In this Declaration, Weiler said the '923 patent was partly inoperative or invalid by reason of his having claimed less than he had a right to claim, and that that deficiency "exists because of errors which were made without deceptive intent on my part."

Weiler alleged "an extraordinary sequence of events which preceded and followed the inadvertent abandonment of original claims 8-11" which made him aware that the invention of the '923 patent was not adequately claimed. His Declaration set forth: (1) a June 23, 1981 letter from patent attorney Earl Tyner to Manzell (co-inventor of the '923 invention) confirming Manzell's authorization to file a divisional application on claims 8-11; (2) Tyner's July 2, 1981 letter to Bryan Burgess (Office of General Counsel, University of Florida), about filing a divisional application; and (3) a January 19, 1982 letter to Mansell from Arthur Yeager, a partner in Tyner's firm, stating that a divisional application had not been filed.

The Declaration further stated that "on being made aware of the failure to timely file the divisional application," Mansell consulted with patent attorney William D. Stokes (counsel of record here), who drafted a set of claims which, he said in the Declaration, "should have been made in the original application."

3. The Reissue Claims

The reissue application contained 20 claims. Claim 13 reads:

13. A method for developing citrus fruit strains low in limonin content, which method comprises identifying by the use of limonin-specific antibodies as a analytical reagent the limonin-low mutants in a breeding or cell culture program, and propagating said mutants.

Claim 19 reads:

19. A gamma globulin fraction comprising antibodies reactive with limonin, said antibodies being formed consequent to injecting into an animal a limonin-protein conjugate.

Claims 1-12 and 20 were allowed by the examiner. Claim 2 was cancelled by Weiler. Claims 13-19 were rejected, and that rejection was appealed to the board.

4. The Board's Action

The board agreed with the examiner's view that "failure to timely file a divisional application including non-elected claims is a deliberate act and not error in the prosecution of the original patent" (citing *in re Orita*, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977)). It sustained the rejection of claims 14-18 on that ground, i.e., because they are "directed to the same subject matter as the non-elected conjugate claims 9 and 10" of the original application. Claims 14-18 are not before us on appeal.

The board sustained the rejection of claims 13 and 19 on this specific ground:

Appeal claims 13 and 19 are directed to subject matter not claimed at all in the original application. As to them, the Examiner's reliance on the case of *In re Rowand et al.* is entirely correct and that decision is controlling. Here, as in that case, "there is nothing in the original patent evidencing that appellants intended to claim (this now claimed subject matter)" (187 USPQ 487 at 489).

Issue

Whether the board erred in sustaining the rejection of claims 13 and 19.

OPINION

Introduction

The starting place is the statute itself, 35 U.S.C. § 251.

Page 675

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

In enacting the statute, Congress provided a statutory basis for correction of "error". The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally. *In re Bennett*, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985) (in banc); *Ball Corp. v. United States*, 729 F.2d 1429, 1439 n.28, 221 USPQ 289, 296 n.28 (Fed. Cir. 1984); *In re Hay*, 534 F.2d 917, 919, 189 USPQ 790, 791 (CCPA 1976). Nonetheless, not every event or circumstance that might be labeled "error" is correctable by reissue.

A. The Parties' Contentions

Weiler says the subject matter of neither claim 13 nor claim 19 constitutes "an independent and distinct invention" from that secured by the original patent, because both subject matters constituted part of the invention which was intended or sought to be secured by the original patent.

Pointing to the letters about a divisional application, on other claims, Weiler says his failure to claim the subject matter of claims 13 and 19 was not deliberate or purposeful, but was caused by the prosecuting attorney's error. He says that "but for the inventors' ignorance of patent drafting technique, their lack of knowledge of claiming technique, and their attorney's obvious lack of understanding of the invention, the subject matter of the part of the invention covered by claims 13 and 19 would have been included in the original patent."

The Solicitor's brief concedes that some minimal support for claims 13 and 19 appears in the patent's specification, but argues that "mere disclosure of this subject matter does not demonstrate an intent to claim this subject matter." The Solicitor's brief also argues that "if a mistake was made [in not filing a divisional application], it is not the type of mistake which can be corrected by reissue," citing *In re Orita*, 550 F.2d 1277, 1281, 193 USPQ 145, 149 (CCPA 1977).¹

B. The Board's Opinion

In its opinion, the board said, as above indicated, that the subject matter of claims 13 and 19 "was not *claimed at all* in the original application" (emphasis added), and that nothing in the patent evidenced an "intent to claim" that subject matter, citing *In re Rowand*, 526 f.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975), as controlling authority.

This court reviews decisions, not the mere language of an opinion. When that language indicates an erroneous basis for the decision, the decision will be reversed, but that is not the case here. The board's language, while infelicitous, simply meant that Weiler's failure to have ever claimed, broadly or narrowly or otherwise, the subject matter of claims 13 and 19, and his failure to show an "intent to claim" that subject matter, indicated absence of the statutorily required "error."

The board's language reflected its well founded recognition that Weiler was seeking to claim subject matter entirely distinct from anything anywhere earlier claimed or attempted or intended to be claimed, and was not seeking to obtain a broadened or narrowed claim to subject matter claimed in the patent proffered for surrender. In dealing with that more common circumstance, one of our predecessor courts said "the whole purpose of the [reissue] statute, so far as claims are concerned, is to permit limitations to be added to claims that are too broad or to be taken from claims that are too narrow." *In re Handel*, 312 F.2d 943, 948, 136 USPQ 460, 464 (CCPA 1963).

C. Disclosure

Weiler argues, on the basis of loose language which, taken out of context, would appear to say that one looks only to see whether the subject matter of a reissue claim appears in the disclosure, and, if it does, a reissue applicant must be granted allowance of that claim. *See* D. Chisum, Patents, § 15.03[3] at 15-53 (1985); I. Kayton, Kayton on Patents, § 22-64 (1985). But the question of support in the

Page 676

disclosure is a § 112 inquiry. If there be no such support, the inquiry ends there, and reissue cannot be obtained. Thus, all consideration of § 251 must await that threshold § 112 determination. In the present case, as above indicated, there is some minimal support for the subject matter of claims 13 and 19.

When, unlike the present case, a reissue applicant seeks to obtain a broadened version of a claim in the patent, one may look to see whether the disclosure "reasonably conveys to one skilled in the art that the inventor had possession of the broad invention at the time the original application was filed." *In re Peters*, 723 F.2d 891, 894, 221 USPQ 952, 954 (Fed. Cir. 1984). That language speaks to the reason why the inventor failed to claim more broadly an invention he had claimed in the patent. It does not speak to the present case, in which Weiler did not claim the subject matter of the reissue claims "at all," to use the board's phrase. The language referring to the "disclosure" in *Peters*, and in other cases dealing with reissue, is directed ultimately to the question of error. One cannot assert error in failing to claim that which was not disclosed at all, or that which was not so disclosed as to indicate that the inventor was possessed of the invention as it is being claimed in the reissue application.

Weiler's argument that the subject matter of claims 13 and 19 does not constitute "an independent and distinct invention" merely because that subject matter can be found somewhere in the overall disclosure of the '923 patent is meaningless. As above indicated, the subject matter must have been disclosed, § 112,

or there is no basis for discussing whether the invention being claimed on reissue is independent or distinct. Moreover, § 251 authorizes reissue for "the" invention disclosed in the original patent, not for just "any" and "every" invention for which one may find some support in the disclosure of the original patent.

The subject matter of claims 13 and 19 are clearly independent of and distinct from each other, from that of elected claims 1-7, from that of non-elected organic compound claims 8 and 11, and from that of non-elected protein compound claims 9 and 10. Weiler would thus have had no right to insert and present claims 13 and 19 in the original application after the examiner's requirement for restriction.

Here too, the question redounds to one of error, for when an applicant makes some disclosure, as Weiler did, of as many as five distinct inventions, claims one, and ignores the rest, it is difficult to find error in the failure to claim those ignored on the sole basis that they were disclosed. To so hold would render meaningless the statutory requirement that an appellant point out and distinctly claim subject matter he regards as his invention. 35 U.S.C. §112, 2d ¶. ²

D. "Intent to Claim"

Language appearing first in the opinion in *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 676, 53 USPQ 6, 9-10 (1942), has been picked up and has metamorphosed into a requirement that an applicant show his original "intent to claim" the subject matter of the reissue claim sought. The phrase "intent to claim" does not appear in the statute. It is but judicial shorthand, signifying a means of measuring whether the statutorily required *error* is present. Clearly, a showing that an applicant had an intent to claim matter he did not claim can go a long way to support a finding that error occurred; and, conversely, a showing that an applicant never had any such intent makes a finding of error extremely difficult if not impossible.

References to "intent to claim" in our cases, though occasionally including § 112 considerations, resolve ultimately into the question of error. "Determining what protection [an inventor] intended to secure by [an] original patent for the purposes of § 251 is an essentially factual inquiry confined to the *objective* intent manifested by the original patent." *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975) (emphasis in original). As explained in a later decision, *Rowand's* test of "intent to claim" was not one of "intent" per se, but looked to "objective indicia of intent." *In re Mead*, 581 F.2d 251, 256, 198 USPQ 412, 417 (CCPA 1978). The court in *Mead*

Page 677

analogized that evidence of "intent" to the written description requirement of § 112, first paragraph, i.e., "a written description of the invention, and of the manner and process of making an using it." *See also In re Peters*, 723 F.2d 891, 894, 221 USPQ 952, 954 (Fed. Cir. 1984). It is true that absence of compliance with §112 will foreclose a finding of "intent" and preclude grant of the reissue, but, as indicated above, that absence dooms the application in any event. The converse is not true. Compliance with § 112 does not alone establish "intent to claim" and does not alone establish error in a failure to claim. ³

This court has recently moved the "intent to claim" approach toward closer conformity with the statute, describing it as merely one factor "that sheds light upon whether the claims of the reissue application are directed to the same invention as the original patent *and the reissue would correct an inadvertent error in the original patent.*" *In re Hounsfield*, 669 F.2d 1320, 1323, 216 USPQ 1045, 1048

(Fed. Cir. 1982) (emphasis added).

E. "Error"

Thus, we arrive at the central question in this appeal, which is not whether there is disclosure, but whether Weiler has established "error" which can be remedied by reissue. The reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application.

The language of *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. at 676, 53 USPQ at 9-10, is relevant here:

[I]t is not enough that an invention *might have been claimed* in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue was intended to have been *covered and secured* by the original. [Emphasis added.]

Weiler and the Solicitor argue as though the "error" to be corrected by reissue were a subjective error. It is not. We do not here deal with "deceptive intention".

Though the term "error" is to be interpreted liberally, *In re Wessler*, 367 F.2d 838, 849, 151 USPQ at 339, (CCPA 1966), Congress did not intend to alter the test of "inadvertence, accident, or mistake" established in relation to the pre-1952 statutes. *In re Wadlinger*, 496 F.2d 1200, 1207, 181 USPQ 826, 831 (CCPA 1974). *See In re Mead*, 581 F.2d 251, 257, 198 USPQ 412, 418 (CCPA 1978) ("conscious choice" not to file continuing application not "error"); *In re Clark*, 522 F.2d 623, 626, 187 USPQ 209, 212 (CCPA 1975) (dereliction in duty of candor not "error"); *In re Byers*, 230 F.2d 451, 454, 109 USPQ 53, 55 (CCPA 1956) (deliberate amendment of claim not "error"). *See also In re Petrow*, 402 F.2d 485, 159 USPQ 449 (CCPA 1968) (cancellation of claim in original application was "error"); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960) (cancellation of claim was "error").

As above indicated, the discussions in the briefs concerning the failure to assert the non-elected claims in a divisional application are irrelevant. Those claims are not on appeal and were drawn to subject matter distinct from that of claims 13 and 19. Though Weiler *might have* filed a divisional application containing claims 13 and 19, there is nothing of record remotely indicating that Weiler or his counsel or anyone else ever thought of doing so, or ever intended doing so, or failed to do so only through error.

Significantly, Weiler accepted issuance of the '923 patent with its claims to a single elected invention. By acquiescing in the examiner's restriction requirement, and failing to file divisional applications on the subject matter of non-elected claims, Weiler foreclosed (because that was not error) his right to claim that subject matter. If it were not error to forego divisional applications on subject matter to which claims had been made in the original application, it cannot on the present record have been error to forego divisional applications on subject matter to which claims had never been made. Nor has Weiler made any showing on which error could be found as the cause of his failure to claim the subject matter of claims 13 and 19.⁴

[1] The board's notation that the subject matter of claims 13 and 19 was "not claimed at all" in the original application, and its finding that nothing in the original patent evidences Weiler's "intent to claim" that subject matter, reflect non-statutory language used by courts and others to support and convey the concept that an inventor's failure to claim particular subject matter was not the result of the "error" required by § 251. Having made that notation and finding, the board should have stated the resulting basis (no error) for its decision. That it did not do so does not require reversal in this case, in which the record clearly supports the notation and finding, Weiler has not shown that either was clearly erroneous, and Weiler has shown nothing in the record that would have required the board to determine that his failure to claim the subject matter of claims 13 and 19 was the result of error.

AFFIRMED

Footnotes

Footnote 1. Because the rejection of claims 14-18 is not appealed, the parties' discussion of the reasons why Weiler failed to file divisional applications on the subject matter of those claims, Weiler's evidence consisting of letters about divisional applications on non-elected claims 8-11, and the Solicitor's reliance on *Orita*, are irrelevant.

Footnote 2. I. Kayton, *Kayton on Patents*, § 22-64 (1985) ("the predecessor to our present statute required that a reissue application be for 'the *same* invention' rather than for 'the *invention disclosed*' in the original patent . . . Now it is only necessary to compare the reissue *claims* with the disclosure in the parent patent for the purpose of determining whether they are supported as required by 35 USC § 112" (emphasis in original)). As indicated in the text, compliance with § 112 is a threshold consideration, but such compliance does not establish error in a failure to claim every disclosed.

Footnote 3. One commentator has recently stated: "The intent test and the *U.S. Industrial Chemicals* statement [see text *infra*] are perhaps best understood as expressions of the 'description of the invention' requirement, which the Court of Customs and Patent Appeals recognizes as distinct from the enablement requirement," D. Chisum, *Patents*, § 15.03[3] at 15-53 (1985). The commentator could not have meant that compliance with § 112's enablement requirement is sufficient in itself to warrant an automatic finding of "intent" and a resulting reissue, in disregard of § 251's requirement to show *error*.

Footnote 4. Weiler's reliance on allegations of the inventors' ignorance of drafting and claiming technique and counsel's ignorance of the invention is unavailing. Those allegations could be frequently made, and, if accepted as establishing error, would require the grant of reissues on anything and everything mentioned in a disclosure. Weiler supplies no facts indicating how the ignorance relied on caused any error as the basis of his failure to claim the subject matter of claims 13 and 19. As indicated in the text § 251 does not authorize a patentee to re-present his application. Insight resulting from hindsight on the part of new counsel does not, in every case, establish error.